

PATENT COOPERATION TREATY

From the:
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

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| To: James & Wells PO Box 2201 Christchurch NEW ZEALAND | | PCT WRITTEN OPINION OF THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY (PCT Rule 66) | |
| | | Date of mailing (day/month/year) 2 5 AUG 2005 | |
| Applicant's or agent's file reference 43043x344 / 32 SE | | REPLY DUE within TWO MONTHS from the above date of mailing | |
| International application No. PCT/NZ2004/000228 | International filing date (day/month/year) 22 September 2004 | Priority date (day/month/year) 22 September 2003 | |
| International Patent Classification (IPC) or both national classification and IPC Int. Cl. ⁷ G06F 17/30 | | | |
| Applicant EUREKSTER, INC et al | | | |

1. ☒ The written opinion established by the International Searching Authority:
☒ is ☐ is not
 considered to be a written opinion of the International Preliminary Examining Authority.

2. This **second** (second, etc.) opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☒ Box No. VIII Certain observations on the international application

3. The applicant is hereby invited to reply to this opinion.

When? See the Reply Due date indicated above. However, the Australian Patent Office will not establish the Report before the earlier of (i) a response being filed, or (ii) one month before the Final Date by which the international preliminary examination report must be established. The Report will take into account any response (including amendments) filed before the Report is established. If no response is filed by 1 month before the Final Date, the international preliminary examination report will be established on the basis of this opinion. Applicants wishing to have the benefit of a further opinion (if needed) before the report is established should ensure that a response is filed at least 3 months before the Final Date by which the international preliminary examination report must be established.

How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

Also For an additional opportunity to submit amendments, see Rule 66.4. For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4bis. For an informal communication with the examiner, see Rule 66.6.

4. The FINAL DATE by which the international preliminary report on patentability (Chapter II of the PCT) must be established according to Rule 69.2 is: 22 January 2006

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| Name and mailing address of the IPEA/AU AUSTRALIAN PATENT OFFICE PO BOX 200, WODEN ACT 2606, AUSTRALIA E-mail address: pct@ipaaustralia.gov.au Facsimile No. (02) 6285 3929 | Authorized Officer MATTHEW HOLLINGWORTH Telephone No. (02) 6283 2024 |
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WRITTEN OPINION OF THE
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

International application No.

PCT/NZ2004/000228

Box No. I **Basis of the opinion**

With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

- ☐ This opinion is based on a translation from the original language into the following language which is the language of a translation furnished for the purposes of:
- ☐ international search (under Rules 12.3 and 23.1 (b))
 - ☐ publication of the international application (under Rule 12.4)
 - ☐ international preliminary examination (under Rules 55.2 and/or 55.3)

2. With regard to the elements of the international application, this opinion has been established on the basis of *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed.")*:

- ☒ the international application as originally filed/furnished
- ☐ the description: pages , as originally filed/furnished
 pages , received by this Authority on with the letter of
 pages , received by this Authority on with the letter of
- ☐ the claims: pages , as originally filed/furnished
 pages , as amended (together with any statement) under Article 19,
 pages , received by this Authority on with the letter of
 pages , received by this Authority on with the letter of
- ☐ the drawings: pages , as originally filed/furnished
 pages , received by this Authority on with the letter of
 pages , received by this Authority on with the letter of
- ☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing.

3. ☐ The amendments have resulted in the cancellation of:

- ☐ the description, pages
- ☐ the claims, Nos.
- ☐ the drawings, sheets/figs
- ☐ the sequence listing (*specify*):
- ☐ any table(s) related to the sequence listing (*specify*):

4. ☐ This opinion has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

- ☐ the description, pages
- ☐ the claims, Nos.
- ☐ the drawings, sheets/figs
- ☐ the sequence listing (*specify*):
- ☐ any table(s) related to the sequence listing (*specify*):

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Box No. V Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

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|-------------------------------|---|-----|
| Novelty (N) | Claims 12, 17, 21-22, 35-37, 45-49, 51-56, 59-60, 63-65, 67, 70-79, 84 | YES |
| | Claims 1-11, 13-16, 18-20, 23-34, 38-44, 50, 57-58, 61-62, 66, 68-69, 80-83 | NO |
| Inventive step (IS) | Claims | YES |
| | Claims 1-84 | NO |
| Industrial applicability (IA) | Claims 1-84 | YES |
| | Claims | NO |

2. Citations and explanations:

- D1: EP 1 288 795 A1 (BRITISH TELECOMMUNICATIONS), 5 March 2003
- D2: H. Kautz et al, *Referral Web: Combining Social Networks and Collaborative Filtering*, March 1997
- D3: US 6,430,558 B1 (DELANO), 6 August 2002
- D4: J. M. Pujol et al, *Porqpine: A Peer-to-Peer Search Engine*, 1 May 2004

NOVELTY (N) claims 1-11, 13-16, 18-20, 23-34, 38-44, 50, 57-58, 61-62, 66, 68-69, 80-83

Claims 1-11, 13-16, 18-20, 23-34, 38-44, 50, 57-58, 61-62, 66, 68-69 and 80-83: These claims are still seen to lack novelty in comparison to D1. Your response appears to suggest that the claims are distinguished from D1 by their use of *indicative information* derived from searches performed by other members of the searcher's social network, however D1 is replete with examples of "indicative information." Paragraph 25 states that the result list is "annotated ... by additional information specifying ... what other referees thought of the result," an arrangement which certainly falls within the scope of claim 1. Even if we are to restrict the meaning of this phrase to those examples given in the description (e.g. the *suggestions* described on pages 7-8 and the *weightings* described on pages 15-16), there are several such instances in the cited art. For example, paragraph 27 describes a *popular web-sites suggestion*, and paragraphs 78-79 describe a *weighting according to connection factor*.

While your response describes the invention as significantly conceptually different from D1, a characterisation of this difference is nowhere reflected in the claims, which merely require the display of "indicative information" from searches performed by other members of the social network.

Claim 1, at least: For similar reasons, claim 1 at least is still seen to lack novelty when compared to D2.

INVENTIVE STEP (IS) claims 1-84

Claims 1-84: These claims lack inventive step in light of D1, as described in the first opinion.

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Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

In claim 84, it is unclear what the clause "a search engine as described above" refers to.